

Claim 15 relates to a device for monitoring at least one measuring system for detecting at least one measured quantity of an electric drive, including at least one controller for receiving the at least one measured quantity detected by the at least one measuring system and for generating at least one manipulated variable for controlling the electric drive. Claim 15 recites that the device includes at least one signal processor for detecting an error in the at least one measuring system.

Claim 29 relates to a device comprising at least one measuring system configured to detect at least one measured quantity of an electric drive. At least one controller is configured to receive at least the measured quantity detected by the measuring system and to generate at least one manipulated variable to control the drive. Claim 29 recites that the device includes at least one signal processor configured to detect errors in the measuring system.

Nashiki purports to relate to a method and apparatus for controlling an electric motor. The Final Office Action at pages 2 to 3 states that it is the Examiner's responsibility to interpret claim language as broadly as possible and effectively equates the controller "speed error" described in Nashiki to the "error in the at least one measuring system" recited in the claims. Applicants point out, however, that during examination, the claims are to be interpreted only as broadly as their terms reasonably allow (see M.P.E.P. 2111.01). Given that the rejected claims specifically recite a controller and a measuring system, the plain meaning of "error in the at least one measuring system" cannot reasonably be interpreted as including error in the controller.

Moreover, Nashiki merely refers to "a speed error DVL." However, Nashiki states that a position sensor 8 is connected to a speed sensor 5 for sensing a rotational speed VL based on a rotational position P. Col. 4, line 66 to col. 5, line 1. Nashiki further states that the speed sensor 5 is connected to a subtracter 1 for subtracting the rotational speed VL from a speed command VLC to determine the speed error DVL. Col. 5, lines 2 to 4. Thus, it is plainly apparent that the "speed error DVL" is merely a value representing the difference between a measured value, i.e., the rotational speed VL, and a command value, i.e., speed command VLC, and does not constitute "an error in [an] at least one measuring system" or "errors in [a] measuring system." Accordingly, it is respectfully submitted that Nashiki fails to disclose, or even suggest, "at least one signal processor for detecting an error in the at least one measuring system" as recited in claim 15 or "at least one signal

processor configured to detect errors in the measuring system" as recited in claim 29.

It is "well settled that the burden of establishing a prima facie case of anticipation resides with the [United States] Patent and Trademark Office." Ex parte Skinner, 2 U.S.P.Q.2d 1788, 1788-89 (Bd. Pat. App. & Inter. 1986) (citing In re Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

As more fully set forth above, it is respectfully submitted that Nashiki does not disclose, or even suggest, a "device for monitoring at least one measuring system for detecting at least one measured quantity of an electric drive, including at least one controller for receiving the at least one measured quantity detected by the at least one measuring system and for generating at least one manipulated variable for controlling the electric drive" as recited in claim 15 or that such a "device includes at least one signal processor for detecting an error in the at least one measuring system" as recited in claim 15. It is therefore respectfully submitted that Nashiki does not anticipate claim 15. It is also respectfully submitted that Nashiki does not disclose, or even suggest, a "device including at least one measuring system configured to detect at least one measured quantity of an electric drive, at least one controller configured to receive at least the measured quantity detected by the measuring system and to generate at least one manipulated variable to control the drive" as recited in claim 29 or that such a device includes "at least one signal processor configured to detect errors in the measuring system" as recited in claim 29. It is therefore respectfully submitted that Nashiki also does not anticipate claim 29.

Moreover, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected

claims, as discussed above. See, Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). In particular, it is respectfully submitted that, at least for the reasons discussed above, the reference relied upon would not enable a person having ordinary skill in the art to practice the inventions of the rejected claims, as discussed above. Also, to the extent that the Examiner is relying on the doctrine of inherency, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art." See M.P.E.P. § 2112; emphasis in original; and see, Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, the anticipation rejection as to the rejected claims must necessarily fail for the foregoing reasons.

In summary, it is respectfully submitted that Nashiki does not anticipate claims 15 or 29.

As for claims 16 to 21 and 25, which ultimately depend from claim 15 and therefore include all of the limitations of claim 15, it is respectfully submitted that Nashiki does not anticipate these dependent claims for at least the same reasons given above in support of the patentability of claim 15.

### **III. Rejection of Claims 22 to 24 and 26 to 28 Under 35 U.S.C. § 103(a)**

Claims 22 to 24 and 26 to 28 have been rejected under 35 U.S.C. §103(a) as unpatentable over Nashiki. Applicants respectfully submit that Nashiki does not render obvious the present claims for the following reasons.

As an initial matter, claims 22 to 24 and 26 to 28 ultimately depend from claim 15 and therefore include all of the limitations of claim 15. As more fully set forth above, it is respectfully submitted that Nashiki does not disclose, or even suggest, all of the limitations of claim 15, from which claims 22 to 24 and 26 to 28 ultimately depend. It is therefore respectfully submitted that claims 22 to 24 and 26 to 28 are patentable over Nashiki. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) (any dependent claim that depends from a non-obvious independent claim is non-obvious).

As regards the present rejection, the Final Office Action merely alleges that the same "approach" used in rejecting the independent claims is used in the

case of "other limitations" and maintains the rejections of the previous Office Action. Specifically, the Final Office Action alleges that "Nashiki teaching can be applied to a control system for a 3-phase ac motor performing two-to-three phase conversion and further to any other control system for multi-phase, multi-pole motors, dc motors and induction motors." Final Office Action at p. 3. However, these contentions are entirely irrelevant to the patentability of the present claims. In particular, these contentions are entirely irrelevant to the issue of whether Nashiki discloses or suggests the limitations of claims 22 to 24 and 26 to 28, for which the Office bears the burden of proof.

In this regard, claim 22 recites that "a measuring system model generates at least one expected estimate for the at least one measuring system for providing error detection in the measuring system." The Final Office Action does not even allege that this limitation is disclosed or suggested by Nashiki. Indeed, it is respectfully submitted that Nashiki does not disclose, or even suggest, this limitation.

As regards claim 23, claim 23 recites that "a reversing switch relays an error signal of the at least one signal processor as a function of the at least one expected estimate." The Final Office Action does not even allege that this limitation is disclosed or suggested by Nashiki. Indeed, it is respectfully submitted that Nashiki does not disclose, or even suggest, this limitation.

As regards claim 24, claim 24 recites that "the at least one signal processor is activatable as a function of at least one of a quantity generated by the at least one controller, and another quantity generated by the at least one controller when it assumes at least one of a certain value and a maximum allowed set point." The Final Office Action does not even allege that these limitations are disclosed or suggested by Nashiki. Indeed, it is respectfully submitted that Nashiki does not disclose, or even suggest, these limitations.

As regards claim 26, claim 26 recites that the device includes "a selector device for making a selection between a first error monitoring and a second error monitoring as a function of a selection quantity." The Final Office Action does not even allege that this limitation is disclosed or suggested by Nashiki. Indeed, it is respectfully submitted that Nashiki does not disclose, or even suggest, this limitation.

As regards claim 27, claim 27 recites that "the selector device makes a selection between the first error monitoring and the second error monitoring as a function of at least one expected estimate for the at least one measuring system." The Final Office Action does not even allege that this limitation is disclosed or suggested by Nashiki. Indeed, it is respectfully submitted that Nashiki does not disclose, or even suggest, this limitation.

As regards claim 28, claim 28 recites that "the measuring system model forms the at least one expected estimate as a function of at least one controller quantity that is at least one of generated by the at least one controller and a function of the at least one controller." The Final Office Action does not even allege that this limitation is disclosed or suggested by Nashiki. Indeed, it is respectfully submitted that Nashiki does not disclose, or even suggest, this limitation.

In rejecting a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, supra. This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As indicated above, it is respectfully submitted that Nashiki does not disclose, or even suggest, all of the limitations of claim 15, from which claims 22 to 24 and 26 to 28 ultimately depend. It is further submitted that Nashiki does not disclose, or even suggest, the additional limitations recited in dependent claims 22 to 24 and 26 to 28, which ultimately depend from claim 15. It is therefore respectfully submitted that Nashiki does not render obvious claims 22 to 24 and 26 to 28, which ultimately depend from claim 15.

Moreover, it is respectfully submitted that the cases of In re Fine, supra, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office Action's generalized assertions do not properly support a § 103 rejection. It is

respectfully submitted that those cases make plain that the Office Action reflects, at best, a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

**Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

**Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].**

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the present Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the reference to provide the claimed subject matter.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a "technologically simple concept" -- which is not the case here -- there still must be some finding as to the "specific understanding or principle within the knowledge of a skilled artisan" that would motivate a person having no knowledge of the claimed subject matter to "make the combination in the manner claimed," stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Again, it is believed that there have been no such findings.

Accordingly, there is no evidence that the reference relied upon, whether taken alone, combined or modified, would provide the features and benefits of claims 22 to 24 and 26 to 28, which ultimately depend from claim 15. It is therefore respectfully submitted that claims 22 to 24 and 26 to 28 are allowable for these reasons.

IV. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON

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By:

Richard L. Mayer  
Reg. No. 22,490

One Broadway  
New York, New York 10004  
(212) 425-7200

Reg. No.  
42,194

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